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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,672	05/24/2001	Bradley Alan Sparks	RCA 88,397	3803

7590

07/31/2006

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EXAMINER

SHIBRU, HELEN

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/864,672	Applicant(s) SPARKS ET AL.	
	Examiner HELEN SHIBRU	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/08/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The RCE filed on 05/08/2006 have been entered and made of record. Claims 1-12 are pending.

### ***Allowable Subject Matter***

2. The indicated allowability of claims 1-10 is withdrawn in view of the newly discovered reference(s) to Yoshinobu et al. (US Pat. No. 5,686,954). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshinobu et al. (US Pat. No. 5,686,954).

Claims 5-12 will be discussed first.

Regarding claim 5, Yoshinobu discloses a receiving device receiving and decoding compressed digital video signals, said receiver device comprising:

a receiving means for receiving and selecting between a first compressed digital video signal from a network source and a second compressed digital video signal and a display

Art Unit: 2621

message data signal from a local source (see figs. 9-10 and col. 13 lines 26-53, col.15 lines 11-15, lines 45-54),

a decoder coupled to said receiving means for decoding said selected one of said first and second compressed digital signals to form a video signal (see decode section in fig. 10 and col. 13 lines 54-65);

control means coupled to said receiving means for controlling selection between said first and second compressed digital video signals, and responsive to selection of said second compressed digital video signal, receiving said display message data signal (see col. 13 lines 48-53, col. 14 lines 14-32, col. 16 lines 14-20, lines 36-42, claims 9-10 and 13, and see fig. 10); and

means for combining a display message formed from said display message data signal with said video signal decoded from said second compressed digital video signal to generate a combined video signal for display (see figures 20-21).

Regarding claim 6, Yoshinobu discloses compressed digital television signal is reproduced from a digital recorder (see figures 20 and 21).

Regarding claim 7, Yoshinobu discloses display message data signal is a recorder status message (see claims 9-10 and 13).

Regarding claim 8, Yoshinobu discloses delay means connected to said control means for delaying transmission of said message data signal to said means for combining (see fig. 20 and 21, the recorded content has been displayed before the judgment inputted).

Regarding claim 9, Yoshinobu discloses receiver selects between said first compressed digital video signal and second compressed digital video signal

responsive a user generated command signal (see figures 9 and 10, and col. 13 lines 26-53, col.15 lines 11-15, lines 45-54).

Regarding claim 10, Yoshinobu discloses an infrared receiver connected to said control means for receiving an infrared signal from a remote control unit, said infrared signal controlling selection between said first compressed digital video signal and second compressed digital video signal (see figure 9 decision and figure 10 component 90, 93, 83 and 100 and rejection of claim 5).

Regarding claim 11, Yoshinobu discloses a delay element, connected to said status message generator, for delaying transmission of said status message signal to said display message combiner (see fig, 14 and col. 9 lines 17-29).

Regarding claim 12, Yoshinobu discloses delay element provides a delay equal to a decoding time of the decoder to thereby synchronize said message signal with said decoded video signal for display (see col. 24 lines 26-33, col. 25 lines 3-15 and lines 29-44).

Regarding claim 1, Yoshinobu discloses a digital apparatus for reproducing a digital video representative signal stored on a recorded medium connected to a receiving device including a decoder (see rejection of claim 5 above), said

apparatus comprising:

means for processing said digital video representative signal stored on the recorded medium to produce at an output a compressed digital video signal bit stream for decoding by the decoder (see claim 1 rejection);

a generator generating a status message signal indicative of an operating mode of said apparatus( see figures 10 and 14 component 100 and rejection of claim 1), and,

a display message combiner having a first input coupled to said message signal and a second input receiving a video signal decoded from said compressed digital video signal bit stream, said combiner combining said message signal with said video signal for display (see claim 1 rejection above).

Regarding claim 2, Yoshinobu discloses status message generator is responsive to a tape timer or time code signal (see fig. 14 component 108).

Regarding claim 3, Yoshinobu discloses generation of said message data signal by said status message generator is in response to receipt of a user generated command signal (see figure 10 components 90,93,83 and figures 20-21 and rejection of claim 9).

Regarding claim 4, Yoshinobu discloses an infrared receiver connected to said status message generator for receiving an infrared signal from a remote control unit, said infrared signal controlling the operating mode of said apparatus (see rejection of claim 10 above).

### ***Conclusion***

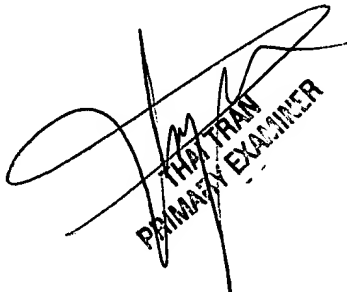
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru  
July 11, 2006



THO TRAN  
PRIMARY EXAMINER